

Application No.: 10/039654

Case No.: 53750US002

**REMARKS****Election/Restriction**

Applicant affirms the election of Group I, Claims 1-7, 9-11 and 15-20.

**35 U.S.C. § 103 Rejections**

Claims 1-7, 9, 10 and 15-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Clark et al. (U.S. Patent 5,853,846) in view of Szekely (U.S. Patent 5,775,835).

The Examiner stated that Clark et al. discloses forming an array of magnetic pavement elements (6) interconnected by a carrier web. The Examiner alleges that the connection between the elements is frangible. The Examiner acknowledges that Clark et al. does not specifically teach the severing of the web around a perimeter of the elements. The Examiner stated that Szekely teaches severing around a perimeter of paving elements in order to utilize different sizes as required by the application (column 4, lines 9-13). The Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have severed around a perimeter of each of the elements of Clark et al. in order to obtain sized suitable for a particular application, as taught by Szekely.

The Applicant submits that the present invention relates to **magnetic pavement elements interconnected by a carrier web**. The method of claim 1 includes forming a frangible connection between each magnetic elements and the carrier web by at least partially severing the carrier web around a perimeter of the magnetic pavement elements. Similarly, the article of claim 15 recites "wherein the magnetic pavement elements are at least partially severed around the perimeter of each pavement element". As defined on p. 10, frangible connection refers to a connection between the carrier web and magnetic pavement elements that is **easily broken** or breakable after application of the magnetic pavement elements to the road. The connections between magnetic pavement elements of Clark are not easily broken and thus are not frangible. The present invention relates to various improvements of Clark et al. in order to provide discrete (i.e. individual) magnetic elements. As described in the background of the invention, magnetic pavement elements are useful for magnetic guidance systems. As described on p. 5 of

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Applicant's patent application, the methods and magnetic pavement elements of the invention are advantageous since the elements employ less material (e.g. no conformance layer).

Accordingly to the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.**

Szekely relates to providing a textured tile for embedment in fresh concrete on a platform or walking surface comprising a generally planar element . . . The textured tiles are not magnetic pavement elements, nor are the textured tiles interconnected by a carrier web. Hence there is no reason to combine Szekely with as suggested by the Examiner other than hindsight based on Applicant's present application for patent.

Reconsideration and a timely allowance are respectfully requested.

Respectfully submitted,

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Date

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